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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,407	02/12/2004	Miguel-Angel Garcia-Martin	P17982-US1	5790

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EXAMINER	
HASHEM, LISA	

ART UNIT	PAPER NUMBER
2614	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/777,407	GARCIA-MARTIN ET AL.	
	Examiner	Art Unit	
	LISA HASHEM	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 December 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 15-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 15-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Amendment, filed 12-18-2007, with respect to the rejection(s) of claim(s) 1-13 and 15-21 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Please see all rejection(s) below.

2. The preliminary amendment filed on 2-12-2004, including claims 1-21, was omitted from examination in the office action filed on 10-3-2007. Therefore, this action is non-final and includes examination of those claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 15, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,917,613 by Tiburtius et al, hereinafter Tiburtius.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Tiburtius discloses a method of setting up a session between first (Fig. 1, 11: an originating Class-A mobile terminal (MT-A)) and second (Fig. 1, 12: a receiving Class-A mobile terminal (MT-B)) peer user terminals of a communication system (Fig. 1) (col. 3, lines 54-60), said session extending at least in part across a circuit switched access network (i.e. C-S Network; Fig. 1, 14), the method comprising the steps of: establishing a packet switched session between the peer user terminals via an Internet Protocol, IP, based packet switched access network (i.e. PDN; Fig. 1, 13; col. 3, lines 63-67) using a call control protocol which is also used for setting up end-to-end packet switched sessions (col. 4, lines 8-18); associating the packet switched session with a circuit switched telephone number (col. 3, lines 40-44; col. 4, lines 10-14); and setting up a circuit switched call between the peer user terminals in parallel with the packet switched session (col. 3, lines 5-15; col. 3, lines 57-63).

Regarding claim 2, the method according to claim 1, wherein Tiburtius discloses further comprising utilizing the circuit switched call to provide one or more conversational bearers (col. 3, lines 57-60; col. 4, lines 8-15).

Regarding claim 3, the method according to claim 2, wherein Tiburtius discloses further comprising utilizing the packet switched session to provide non-conversational bearers established over said IP based packet switched network (col. 3, lines 60-67; col. 4, lines 15-29).

Regarding claim 4, the method according to claim 1 wherein, Tiburtius

discloses at least one of the peer user terminals is a dual mode mobile terminal (i.e. Class-A mobile terminal) capable of using both said packet switched and circuit switched access networks (col. 3, lines 46-48).

Regarding claim 15, Tiburtius discloses user terminal (Fig. 1: 11, 12; a Class-A mobile terminal (MT-A)) comprising: means for using a circuit switched access network (i.e. C-S Network; Fig. 1, 14); means for using an Internet Protocol, IP, based packet switched access network (i.e. PDN; Fig. 1, 13; col. 3, lines 63-67); and means for transferring signalling information, using a call control protocol (i.e. GPRS Attach procedure; col. 3, lines 32-36; col. 4, lines 19-22) which is also used for setting up end-to-end packet switched sessions (col. 4, lines 8-18), over the packet switched network to initiate in parallel, both a packet switched session over the packet switched network and a circuit switched call over the circuit switched network (col. 3, lines 5-15; col. 3, lines 57-63).

Regarding claim 18, the user terminal of claim 15, wherein Tiburtius discloses the terminal is a dual mode mobile terminal (i.e. Class-A mobile terminal) capable of using said packet switched and circuit switched networks (col. 3, lines 46-48).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiburtius, as applied to claim 1 above, and in view of Ejzak.

Regarding claim 5, Tiburtius does not disclose the step of establishing a packet switched session includes utilizing the Session Initiation Protocol, SIP, between at least one of the peer user terminals and a SIP server of an IP Multimedia Core Network Subsystem (IMS).

Ejzak discloses a method of setting up a session between first and second peer user terminals (Fig. 1, 111; col. 2, lines 31-33; col. 3, lines 37-43; col. 4, lines 26-43) of a communication system (Fig. 1), said session extending at least in part across a circuit switched access network (i.e. PSTN; Fig. 1, 161), the method comprising the steps of: establishing a packet switched session between the peer user terminals via an Internet Protocol, IP, based packet switched access network using a call control protocol (i.e. SIP) which is also used for setting up end-to-end packet switched sessions; and subsequently establishing said session based upon said signalling (col. 4, lines 26-40; col. 5, lines 35-52; col. 8, line 57 – col. 9, line 18).

Wherein Ejzak discloses the step of establishing a packet switched session includes utilizing the Session Initiation Protocol, SIP, between at least one of the peer user terminals and a SIP server (i.e. CSCF; Fig. 1, 143; col. 4, lines 34-40 and lines 46-50) of an IP Multimedia Core Network Subsystem (IMS) (Fig. 1, 141; (IMS)) (col. 5, lines 36-52; col. 8, line 57 – col. 9, line 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Tiburtius to include establishing a packet switched session includes utilizing the Session Initiation Protocol, SIP, between at least one of the peer user terminals and a SIP server of an IP Multimedia Core Network Subsystem (IMS) as taught by Ejzak. One of ordinary skill in the art would have been lead to make such a modification to

establish a packet switched session between the peer user terminals. The method of Tiburtius is provided with the SIP protocol of the communication system in Ejzak to allow the system to provide voice and data services to the peer user terminals.

Regarding claim 6, the method according to claim 5, wherein Ejzak discloses said SIP server notifies a gateway server (i.e. MGW -> media gateway; Fig. 1, 148) when it receives a session initiation request which requires establishing at least one conversational bearer, the gateway setting up the circuit switched call within the system (col. 3, lines 37-43; col. 4, lines 34-40; col. 5, lines 36-40).

Regarding claim 7, the method according to claim 6, wherein Ejzak discloses said SIP server and said gateway server are co-located (Fig. 1, 141) (col. 4, lines 10-24; col. 5, lines 6-13).

Regarding claim 8, the method according to claim 6, wherein Ejzak discloses the gateway server provides interworking between the circuit switched call and the packet switched session (col. 2, lines 21-24; col. 5, line 9 – col. 6, line 7).

Regarding claim 9, the method according to claim 8, wherein Ejzak discloses following notification from the SIP server, the gateway server notifies said at least one of the peer user terminals of a callback telephone number, and the peer user terminal calls that number to initiate the circuit switched call with the gateway server (col. 3, line 60 – col. 5, line 52).

Regarding claim 10, the method according to claim 9, wherein Ejzak discloses at least one peer terminal is notified of the callback number is via the SIP server (col. 3, line 60 – col. 5, line 52).

Regarding claim 11, the method according to claim 10, wherein Ejzak discloses the gateway server maps the established circuit switched call to the packet switched session based on the used callback number (col. 3, line 60 – col. 5, line 52).

Regarding claim 12, the method according to claim 9, wherein Ejzak discloses the gateway server selects the callback number from a pool of available callback numbers (col. 3, line 60 – col. 5, line 52).

Regarding claim 13, the method according to claim 5, further comprising Ejzak determining by the SIP server that said session requires setting up of a circuit switched call as a result of one or more of the following:

properties of the system known to the SIP server;

prior notification by said at least one of the peer user terminals;

information contained in the SIP signalling initiating the session;

properties defined for the peer user terminal;

prior notification from a visited network if a peer user terminal is roaming;

and prior notification from the radio access network used by the peer user terminal (col. 4, line 44 – col. 5, line 52; col. 8, line 57 – col. 9, line 18).

7. Claims 16, 17, 20 and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Ejzak in view of Tiburtius.

The applied reference (Tiburtius) has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was

derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claim 16, Ejzak discloses a Session Initiation Protocol server (i.e. S-CSCF) for use in an Internet Protocol, IP, Multimedia Core Network Subsystem (Fig. 1, 141; (IMS)) (col. 5, lines 41-52), the server comprising: means for receiving an INVITE request from a user terminal (i.e. mobile unit) (col. 8, lines 57-65), over an IP based packet switched domain (Fig. 1, 131; col. 3, lines 52-59), initiating a packet switched session; means for determining that the packet switched session requires setting up of at least one circuit switched conversational bearer (i.e. PSTN; Fig. 1, 161); and means for causing the at least one conversational bearer to be set up (col. 8, line 7 – col. 9, line 11).

Ejzak discloses interworking between circuit switched and packet switched networks. However, Ejzak does not disclose both a packet switched session and a circuit switched call in parallel.

Tiburtius discloses over an IP based packet switched domain (i.e. PDN; Fig. 1, 13; col. 3, lines 63-67), initiating a packet switched session (col. 4, lines 8-18); means for determining that

the packet switched session requires setting up of at least one circuit switched conversational bearer (i.e. C-S Network; Fig. 1, 14); and means for causing the at least one conversational bearer to be set up in parallel with the packet switched session (col. 3, lines 5-15; col. 3, lines 57-60; col. 4, lines 8-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Ejzak to include both a packet switched session and a circuit switched call in parallel as taught by Tiburtius. One of ordinary skill in the art would have been lead to make such a modification to carry real time voice and data simultaneously. The method of Ejzak is provided with the parallel session of the communication system in Tiburtius to allow the system to provide voice and data services to the peer user terminals.

Regarding claim 17, Ejzak discloses a gateway server (i.e. MGW -> media gateway; Fig. 1, 148) for providing an interface between a circuit switched access network (i.e. PSTN; Fig. 1, 161) and a packet switched network (Fig. 1, 131; col. 3, lines 52-59) (col. 2, lines 21-24; col. 5, line 9 – col. 6, line 7), the gateway server having an interface towards a Session Initiation Protocol, SIP, server (i.e. CSCF; Fig. 1, 143; col. 4, lines 34-40 and lines 46-50) of an Internet Protocol, IP, Multimedia Core Network Subsystem (Fig. 1, 141; (IMS)) (col. 5, lines 41-52), said gateway server comprising: means for receiving from the SIP server, signalling instructing the setting up of a circuit switched call over the circuit switched access network with a user terminal (Fig. 1, 111) (col. 3, lines 37-43; col. 4, lines 34-40; col. 5, lines 36-40).

Ejzak discloses interworking between circuit switched and packet switched networks. However, Ejzak does not disclose both a packet switched session and a circuit switched call in parallel.

Tiburtius a communication system (Fig. 1) for providing an interface between a circuit switched access network (i.e. PSTN; Fig. 1, 161) and a packet switched network (Fig. 1, 131; col. 3, lines 52-59) (col. 2, lines 21-24; col. 5, line 9 – col. 6, line 7); and means for setting up the circuit switched call in parallel with a packet switched session (col. 3, lines 5-15; col. 3, lines 57-60; col. 4, lines 8-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the server of Ejzak to include both a packet switched session and a circuit switched call in parallel as taught by Tiburtius. One of ordinary skill in the art would have been lead to make such a modification to carry real time voice and data simultaneously. The method of Ejzak is provided with the parallel session of the communication system in Tiburtius to allow the gateway server to provide voice and data services to the peer user terminals.

Regarding claim 20, the server of Claim 16, wherein Ejzak discloses further comprising means for notifying a gateway server upon determining that the at least one conversational bearer in the circuit switched domain is required (col. 3, lines 37-43; col. 4, lines 34-40; col. 5, lines 36-40) and causing said gateway server to provide a call-back number to said user terminal (col. 3, line 60 – col. 5, line 52).

Regarding claim 21, the gateway server of Claim 17, wherein Ejzak discloses further comprising means for providing said user terminal with a call-back number for said user terminal to call to initiate a circuit switched call with said gateway server (col. 3, line 60 – col. 5, line 52).

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiburtius, as applied to claim 15 above, and in view of Ejzak.

Regarding claim 19, the user terminal of claim 15, Tiburtius does not disclose further comprising: means for receiving a call-back number from a gateway associated with said packet switched and circuit switched networks; and means for setting up a circuit switched call with said gateway by calling that call-back number.

Ejzak discloses user terminal (Fig. 1, 111; col. 3, lines 37-43) comprising means for using a circuit switched access network (i.e. PSTN; Fig. 1, 161) and means for using an Internet Protocol, IP, based packet switched access network (Fig. 1, 131; col. 3, lines 52-59); and means for transferring signalling information, using a call control protocol (i.e. SIP) which is also used for setting up end-to-end packet switched sessions, over the packet switched network to initiate a session over the circuit switched network (col. 4, lines 26-40; col. 5, lines 35-52).

Ejzak discloses further comprising: means for receiving a call-back number from a gateway associated with said packet switched and circuit switched networks; and means for setting up a circuit switched call with said gateway by calling that call-back number (col. 3, line 60 – col. 5, line 52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user terminal of Tiburtius to include a call-back number as taught by Ejzak. One of ordinary skill in the art would have been lead to make such a modification to establish a circuit switched session between the peer user terminals and the gateway. The user terminal of Tiburtius is provided with the call-back number of the gateway in Ejzak to allow provide interworking between circuit switched session on one side and the packet switched session on the other side.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

10. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LISA HASHEM whose telephone number is (571)272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fan Tsang/
Supervisory Patent Examiner, Art Unit 2614

/Lisa Hashem/
Examiner, Art Unit 2614